

Mailed:
February 5, 2003

This Opinion is Not
Citable as Precedent
of the TTAB

Paper No. 13
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sierra Design Group

Serial No. 76/154,885

Kirstin M. Jahn of Jahn & Associates, LLC for Sierra Design Group.

Andy Corea, Trademark Examining Attorney, Law Office 101
(Jerry Price, Managing Attorney).

Before Seeherman, Hairston and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Sierra Design Group has filed an application to register the mark PENNY JUNCTION for goods identified as "gaming equipment, namely, slot machines with or without a video output, electromechanical gaming equipment and electronic gaming equipment."¹ During prosecution,

¹ Serial No. 76/154,885, in International Class 9, filed October 26, 2000, based on applicant's allegation of first use and first use in commerce as of January 28, 2000.

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applicant acceded to the examining attorney's requirement that applicant enter a disclaimer of PENNY.

The examining attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), because of the prior registration of JACKPOT JUNCTION and design (shown below) for "gaming equipment, namely, video slot machines."²



The registration includes a disclaimer of JACKPOT and the following description: "The mark consists, in part, of the stylized representation of a treasure map to find the jackpot." When the examining attorney made the refusal of registration final, applicant appealed. Applicant filed a request for reconsideration that the examining attorney denied. Both applicant and the examining attorney have filed briefs, but an oral hearing was not requested.

² Registration No. 2,160,583, issued May 26, 1998, in International Class 9, and listing October 1, 1996 as the registrant's date of first use and first use in commerce.

The determination under Section 2(d) of the question of likelihood of confusion is based on an analysis of all of the probative facts that are relevant and for which there is evidence of record. See *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In the analysis of likelihood of confusion presented by this case, key considerations are the similarities of the marks, the identical nature of the goods, in part, and the presumptively identical nature of classes of purchasers and ultimate users of the involved goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

A preliminary matter to be considered is applicant's attempt, through its request for reconsideration, to rely on third-party registrations and applications to show weakness in the cited mark (each of the marks referenced by applicant includes the term "junction" and, according to applicant, is registered in, or is the subject of an application in, Class 9). In his denial of applicant's request for reconsideration, and again in his brief, the examining attorney quite clearly explained that applicant's submission of a list of marks with their corresponding registration or application numbers was insufficient to place the third-party registrations in the record. We

agree, as the law in this regard is quite settled. Mere listings of registrations, or copies of private company search reports, are not sufficient to make the registrations of record. See *In re Dos Padres Inc.*, 49 USPQ2d 1860, n. 2 (TTAB 1998), and *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, n. 6 (TTAB 1996); see also, *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974). Moreover, even if the law allowed consideration of the list, we note that 14 of the 34 marks in the list are "dead" (i.e., the registrations have either expired or otherwise been cancelled and the applications have been abandoned³); also, the mere fact that the 20 "live" filings all cover, in whole or in part, Class 9 goods does not establish that the goods are related in any way to the goods covered by the involved application and cited registration.⁴ In sum, even if we could consider the list, it would have no probative value.

We begin our analysis of the likelihood of confusion by noting that the applicant's and registrant's goods are,

³ We also note that, "live" or "dead," copies of third-party applications are evidence only of the filing of such applications. *Zappia-Paradiso, S.A. v. Cojeva Inc.*, 144 USPQ 101 (TTAB 1964).

⁴ The variety of goods in Class 9 is so broad that even identical marks could coexist within the class for widely divergent goods. See the summary listing of Class 9 goods that appears at 37 C.F.R. § 6.1.

at least in part, identical. Registrant's goods are video slot machines and these are encompassed by applicant's identification of goods. In addition, while applicant argues that it is significant that its slot machines are "penny" slots, neither applicant's nor registrant's identification is restricted and each must be read to include video slot machines requiring money or equivalent tokens of various denominations, including pennies, nickels, quarters, etc. While it may be unrealistic to assume the possibility of applicant using PENNY JUNCTION on a video slot machine that requires more than a penny, we must nonetheless consider the concurrent use of the marks on penny video slot machines, as there is nothing in registrant's identification that, per se, excludes use of its JACKPOT JUNCTION and design mark on such machines.

When marks will appear on virtually identical goods or services, "the degree of similarity [between marks] necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Turning to a comparison of the marks, applicant's mark is PENNY JUNCTION in typed form. Applicant argues that, in contrast to the registered mark, applicant's mark is displayed in a different form of lettering from that in the

JACKPOT JUNCTION and design mark, is displayed in different colors, and is accompanied by different trade dress (specifically, the design of a penny that, according to applicant, reinforces PENNY as the dominant term in applicant's mark, notwithstanding that PENNY has been disclaimed). Applicant also argues that the cited mark includes a design element and this composite mark creates a different impression than applicant's mark and trade dress.

It is well-settled, however, that when one applies to register a mark in typed form, the Board must consider that it could be displayed in any form or size of lettering, including the slightly stylized form of display utilized for the words in the registered mark. *Phillips Petroleum Co. v. C. J. Webb, Inc.*, 442 F.2d 1376, 170 USPQ 35 (CCPA 1971), and *Jockey International Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233 (TTAB 1992). Further, we cannot consider applicant's trade dress as an element that could help distinguish applicant's mark from registrant's mark, for the trade dress is not part of the mark in the application and applicant is free to change it or abandon it at any time. *Vornado, Inc. v. Breuer Electric Mfg. Co.*, 390 F.2d 724, 156 USPQ 340, 342 (CCPA 1968).

As a result, the marks we compare are JACKPOT JUNCTION and design and PENNY JUNCTION. Both JACKPOT and PENNY have

been disclaimed because of their descriptiveness. As the examining attorney has correctly observed, while disclaimed terms are considered in the comparison of marks, and in an appropriate case may contribute to a finding of no likelihood of confusion, disclaimed matter is typically less significant or less dominant than other components of trademarks. *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976). Each mark creates the same commercial impression of a place, a "Junction." In applicant's mark, that place is one in which a penny will do; in registrant's mark, the place is one where a jackpot may be found. In this case, we find the similar commercial impressions created by the marks to be more significant than the visual difference resulting from registrant's use of a map design and the pronunciation difference resulting from use, on the one hand, of PENNY and, on the other hand, of JACKPOT. That is, the word JUNCTION is identical in both marks; and the descriptive elements PENNY and JACKPOT, and the design element in the cited mark, are not sufficient to create marks with different commercial impressions.

Turning to the channels of trade and classes of customers for the goods, there are no restrictions in either identification and we must assume that the goods can

be marketed to the same classes of purchasers, through the same channels of trade, and that the slot machines will be made available to any end user willing to deposit the necessary money or equivalent token. It is generally known and not subject to reasonable dispute that the gaming and casino industry is highly regulated and that the respective goods, even without any restriction included in the identifications, can be considered as generally targeted only to business purchasers in the gaming and casino industry. Even though there is nothing in the record to support the argument, we accept as reasonable applicant's contention that purchasers of video slot machines will be deliberative in their purchases. Nonetheless, the Board's focus is not solely on purchaser confusion, but must also encompass likely confusion among ultimate users of applicant's machines and registrant's services.

Accordingly, the Board must consider whether casino patrons who may be exposed to one of the involved marks on a video slot machine would, if exposed to the other mark on another video slot machine, be mistaken or confused or deceived. Casino patrons would likely conclude, because of the similarities of the marks, that the machines have a common source or sponsorship.

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Given the similar commercial impressions of the marks, the identical nature of the goods, the overlap between purchasers and prospective end users, the Board finds that there exists a likelihood of confusion, mistake or deception. Finally, if we had any doubt on the issue, we would have to resolve that doubt in favor of the prior user and registrant. *Kenner Parker Toys v. Rose Art Industries*, 963 F.2d 350, 22 USPQ2d 1453, 1458 (Fed. Cir. 1992).

Decision: The refusal under Section 2(d) of the statute is affirmed.